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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,667	10/17/2000	Steven MacWilliams	00725.0360-US-01	3418

22865 7590 12/29/2006
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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/690,667

Applicant(s)

MACWILLIAMS, STEVEN

Examiner

Mark T. Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25,30,31,34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35 is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-23, 25, 30, 31, 34 is/are rejected.
- 7) ☐ Claim(s) 18 and 24 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Art Unit: 3722

DETAILED OFFICE ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 4, 10-12, 22, 30 and 35 have been amended for further examination. Claims 26-29 and 32-33 have been canceled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4, 5, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Swallow (5,820,958).

Swallow discloses in Fig. 1, 4 and Attachment I, a label comprising a substantially planar first layer (12) having a first surface; a second layer (11) including a non-adhesive label material having an adhesive (16 and 18), which is permanently attached to the second surface (12b) of the first layer (12); the second layer (11) having an adhesive (13) on an outer surface (11b) of the non-adhesive material or second layer (11); the non-adhesive label material (11) having a first section (A) and a second section (B) and a gap (C) of discontinuity defining a section in the first layer; wherein the second layer (11) covering all of the second surface (12B) except for the line section (C); wherein the second layer has a thickness.

In regards to **Claims 1 and 4**, wherein a label is “for attaching over an edge of a stock member to insure reliably folding along a fold-line over said edge”; and a gap for “providing a way to reliably fold along said line”, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the attachable label is capable of insuring reliable folding along a fold-line; and the gap is capable of providing a way to reliably fold along a line and provide visual discernability.

In regards to **Claim 1**, wherein a folding pressure is applied such that the label folds along a section such that the first section of the second layer is attached to a first side of a stock

member and the second section is attachable to a second side of a stock member, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the label of Swallow can be: folded onto a stock member when a folding pressure has been applied; the gap can be used to indicate any type of line or section.

3. Claims 1, 2, 4-6, 10, 11, 15-17, 19, 20, 30, 31, 34, 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Cunningham (3,348,324).

Cunningham discloses in Fig. 4, 5 and 15, a label for attaching over an edge of a stock, wherein the label comprises: a planar first layer (22) having a first surface (see in Fig. 5), and a second surface (seen in Fig. 4); a second layer (24, 25, 27), which is permanently attached to the second surface of the first layer (as seen in Fig. 15); the second layer having an adhesive (27) on an outer surface of the non-adhesive material (Col. 2, lines 55-60); the non-adhesive material having a first section (24 and 27L) and a second section (25 and 27R) with a gap (26) therebetween; the gap (26) defining a fold-line section (or hinge portion as stated in Col. 2, line 52) and comprising complete separation between the second layer sections to provide visually discernability the fold line with the gap; the second layer covering all of the second surface of the first layer (as seen in Fig. 15) except the fold-line section (26), wherein a folding pressure is applied to the label such that the fold-line section is attachable to a first side of a stock member and the second section is attachable to a second side of the stock member (as seen in Fig. 4, 5

and 7); wherein the fold line section (260 is offset from a centerline of the first layer (as seen in Fig. 15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-9, 12-14, 21-23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham.

Cunningham discloses a label comprising all of the elements as disclosed in Claims 1 and 11. However, Cunningham does not disclose: wherein the second layer has at least two gaps; wherein the second layer has a thickness wherein the neither the first or second section bends when pressure is applied; wherein the second layer comprises a dark material or a light material; wherein the second layer comprises a security label material.

In regards to **Claims 7 and 21**, It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any number of gaps to reveal foldable section, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to one having

ordinary skill in the art to incorporate any number of gaps in the second layer to discern the foldable section, and invention would function equally as well with any number or one.

In regards to **Claims 8**, it would have been obvious to construct the second layer in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been obvious to construct the second layer in any desirable size, since applicant has not disclosed the criticality of having a particular size dimension (width, thickness, height), and invention would function equally as well in any desirable size dimension.

In regards to **Claim 9, 12-14, 22, and 23**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desirable material to distinguish sections, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Therefore, it would have been obvious to construct the second layer with any desired material, since applicant has not disclosed the criticality of using a particular material, and invention would function equally as well with any desired material.

Allowable Subject Matter

1. Claim 35 is allowed.

2. Claims 18 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sarajian discloses a similar label.

Response to Arguments

Applicant's arguments filed on October 26, 2006 have been fully considered but they are not persuasive.

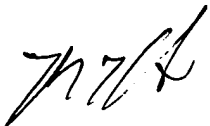
In response to applicant's arguments that the Swallows reference does not disclose. "for attaching over an edge of a stock member to insure reliably folding along a fold-line over said edge"; and a gap for "providing a way to reliably fold along said line", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior

art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the attachable label is capable of insuring reliable folding along a fold-line; and the gap is capable of providing a way to reliably fold along a line and provide visual discernability.

Cunningham is now used to disclose a label for attaching to an edge of a stock member wherein the first layer is transparent to allow for visual discernability of the fold line gap section in the second layer.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Monica Carter, can be reached at (571) 272-4475. The formal fax number for TC 3700 is (571) 273-8300.



MTH

December 17, 2006

